



UNITED STATES PATENT AND TRADEMARK OFFICE

fw)

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/664,969	09/16/2000	Robert Antonacci	865-002u	4464
7590	06/14/2006		EXAMINER	
SOFER & HAROUN L.L.P. 317 MADISON AVENUE SUITE 910 NEW YORK, NY 10017			PARK, CHAN S	
			ART UNIT	PAPER NUMBER
			2625	

DATE MAILED: 06/14/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/664,969	ANTONACCI ET AL.	
	Examiner	Art Unit	
	CHAN S. PARK	2625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 02 May 2006.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-52 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-52 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 29 March 2004 is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

DOUGLAS Q. TRAN
PRIMARY EXAMINER

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
 Paper No(s)/Mail Date _____.

- 4) Interview Summary (PTO-413)
 Paper No(s)/Mail Date. _____.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 5/2/06 has been entered. Currently, **claims 1-52** are pending.

Response to Arguments

2. Applicant's arguments with respect to **claims 1-52** have been considered but are moot in view of the new ground(s) of rejection.

Drawings

3. The drawings are objected to because the word "AAROPRIATE" is misspelled in step 1050 of fig. 10(b). Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered

and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claim 3 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. It is respectfully noted, based on the Specification, that the coded information having a barcode only represents the account information, not the medical record. If the coded information comprises the medical record, it is unclear what the various types of information represent. Clarification/explanation from the Specification is requested.

5. With respect to claim 19, arguments analogous to those presented for claim 3, are applicable.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 3, 4, 9, 24, 29-34, 37-41, 43, 44 and 45-51 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

6. Claims 3 and 4 recite the limitation "said coded-associated information material". There is insufficient antecedent basis for this limitation in the claim. It is unclear if said coded-associated information material is referring to the various types of information or the coded information.

7. With respect to claim 4, it is unclear whether the code-associated information material comprises a fax cover sheet or the fax cover sheet comprises the code-associated information material.

8. Claim 9 recites the limitations "said information materials" in line 2 and "said coded information material" in lines 3-4. There are insufficient antecedent basis for this limitations in the claim. It is unclear if said information materials are referring to said various types of information or said coded information. Further, it is unclear if said coded information material is referring to said coded information. How is the information material different from just the information?

Art Unit: 2625

9. Claim 24 recites the limitation "said information material" in line 2. There is insufficient antecedent basis for this limitation in the claim. It is unclear if said information material is referring to the medical information or the coded information.

10. With respect to claim 29, it is uncertain if the storage locations recited in the claim are different from the memory location recited in claim 21.

Clarification/explanation from the Specification is respectfully requested.

11. With respect to claim 30, the limitation, "the step of storing in an patient authentication data module of said storage means said identification numbers", is extremely confusing. What is stored and where is it stored? Where is said storage means located?

12. Claim 31 recites the limitation "said coded information material" in line 2. There is insufficient antecedent basis for this limitation in the claim.

13. Claim 32 recites the limitation "said encrypted information materials" in line 2. There is insufficient antecedent basis for this limitation in the claim.

14. Claim 33 recites the limitation "an identification number" in line 2. There is insufficient antecedent basis for this limitation in the claim. It is unclear if this identification data is the same identification number recited in claim 27.

15. Claim 34 recites the limitation "an identification number and authentication data" in lines 2-3. There is insufficient antecedent basis for this limitation in the claim.

16. With respect to claim 36, arguments analogous to those presented for claim 34, are applicable.

17. Claim 37 recites the limitation “transmitting information” in line 6. There is insufficient antecedent basis for this limitation in the claim. It is unclear as to exactly what information is transmitted to the processor? Is it the medical information or the coded information?

Furthermore, claim 37 recites the limitation “said facsimile images of said documents” in lines 7-8. There is insufficient antecedent basis for this limitation in the claim.

18. Claim 38 recites the limitation “said associating step comprises associating said code”. There is insufficient antecedent basis for this limitation in the claim.

19. With respect to claim 39, it is unclear as to what is appended to the barcode or said information material. It is further unclear what this “said information” is referring to. Is it the medical information or the coded information?

20. With respect to claim 40, arguments analogous to those presented for claim 39, are applicable.

21. Claim 41 recites the limitation “a barcode... configured to be separately transmitted along with a patient’s medical record”. It is unclear if the barcode is transmitted along with the medical record or transmitted separately from the medical record.

Furthermore, claim 41 recites the limitation “transmit[ting] various medical records corresponding to said patient”. It is unclear as to where the various medical records are transmitted to. Is it to the patient or the processor?

Furthermore, claim 41 is construed as an apparatus claim but the last part of the claim appears to recite a method step. Appropriate correction is respectfully requested.

22. Claim 43 recites the limitation "said patient access information". There is insufficient antecedent basis for this limitation in the claim.
23. Claim 44 recites the limitation "said information". There is insufficient antecedent basis for this limitation in the claim. Which information is it referring to?
24. Claim 43 recites the limitation "an identification number or name and an access code". It is unclear if these are the doctor's information or the patient's.
25. Claim 43 recites the limitation "a password". There is insufficient antecedent basis for this limitation in the claim. Whose password is this?
26. With respect to claims 49 and 50, are these referring to information listed in claim 44 or claim 45?
27. With respect to claim 51, it is unclear how the second coded information can be comprised in the system of claim 1. Is the second coded information a physical means?

Claim Objections

The following quotations of 37 § CFR 1.75(d)(1) is the basis of objection:

(d)(1) The claim or claims must conform to the invention as set forth in the remainder of the specification and the terms and phrases used in the claims must find clear support or antecedent basis in the description so that the meaning of the terms in the claims may be ascertainable by reference to the description. (See § 1.58(a)).

28. Claim 10 recites the limitation "said identification numbers of said patients and said corresponding authentication data". There is insufficient antecedent basis for this limitation in the claim. Perhaps, it should be -- a plurality of identification numbers of a

Art Unit: 2625

plurality of patients and a corresponding authentication data --. Further, it is unclear what the authentication data is corresponding to.

29. Claim 12 recites the limitation "said encrypted information materials". There is insufficient antecedent basis for this limitation in the claim.

30. Claim 14 recites the limitation "an identification number and authentication data". Perhaps, it should be -- the identification number and the authentication data --.

31. Claim 16 recites the limitation "an identification number". Perhaps, it should be -- the identification number --.

32. Claim 30 recites the limitation "said identification numbers of said patients". There is insufficient antecedent basis for this limitation in the claim.

33. Claim 41, line 1, -- , -- should be inserted after "medical records".

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hull et al. U.S. Patent No. 6,665,086 (hereinafter Hull) in view of James et al. U.S. Patent No. 6,742,161 (hereinafter James).

34. With respect to claim 1, Hull discloses a system (fig. 1) comprising:

means (document management workstation 108 in conjunction with disk storage 114) for receiving various types of information from a plurality of corresponding sources of said information via facsimile devices (110), said facsimile devices configured to transmit a facsimile image of a document containing said various types of information (scanned, faxed document in col. 6, line 53 – col. 7, line 27) relating to an account (col. 7, lines 19-27), along with a code information for identifying the sender thereon, said code information used to associate said document with said account (col. 8, lines 12-23);

means for communicating with an interactive user device (client system 102 in col. 8, lines 30-55); and

a processor (108) coupled to said interactive user device via Internet and to said facsimile devices via a public-switched telephone network (fig. 7), wherein said processor is further configured to receive from said facsimile devices a transmission of said facsimile image of said document and said code information, said processor configured to automatically store said transmitted facsimile image of said document in a database location relating to said account associated with said code information on said separate facsimile form and to provide to an authorized user of said interactive user device, upon request at any time, access to said facsimile image of said document (col. 8, lines 30-55).

Hull, however, does not disclose expressly that the code information is included in a separate facsimile form.

James, the same field of endeavor of the facsimile communication, teaches a method of sending facsimile image along with a barcode on a facsimile cover sheet for identifying the sender information (col. 6, lines 38-56).

At the time of the invention, it would have been obvious to one of ordinary skill in the art to implement the method of identifying the sender using the barcode on the facsimile cover sheet into the system of Hull.

The suggestion/motivation for doing so would have been to identify the sender using the barcode printed on the facsimile cover page.

Therefore, it would have been obvious to combine Hull and James to obtain the invention as specified in claim 1.

Claims 2-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Hull and James as applied to claim 1 above, and further in view of Rozen et al. U.S. Patent No. 6,073,106 (hereinafter Rozen).

35. With respect to claim 2, the combination discloses the system according to claim 1, but it does not disclose expressly that said various types of information is various types of medical record.

Rozen, the same field of endeavor of the facsimile communication, discloses a method of sending various types of medical record information using facsimile communication (col. 6, lines 49-67).

At the time of the invention, it would have been obvious to one of ordinary skill in the art to implement the system of Hull to archive the medical information in the disk storage 114.

The suggestion/motivation for doing so would have been to archive the transmitted medical record in the database for later retrieval.

Therefore, it would have been obvious to combine three references to obtain the invention as specified in claim 2.

36. With respect to claims 3 and 4, James teaches a step of sending facsimile image along with a barcode on a facsimile cover sheet for identifying the sender information (col. 6, lines 38-56).

37. With respect to claim 5, it is inherent that the system includes a barcode generator to produce a fax cover sheet having the barcode.

38. With respect to claim 6, James teaches a step of sending facsimile image along with a barcode on a facsimile cover sheet for identifying the sender information (col. 6, lines 38-56). Thus, the barcode reader is an inherent feature.

39. With respect to claims 7 and 8, the combination of Hull and James teaches the system according to claim 6, wherein said barcode corresponds to an identification number associated with a sender (col. 7, lines 19-27 of Hull and col. 6, lines 38-67 of James), wherein the sender is construed as a patient in view of Rozen.

40. With respect to claims 9 and 10, Hull discloses the system further comprising a storage means having storage locations for storing said information materials; wherein

said processor is further configured to store said information materials in a storage location corresponding to said coded information material (col. 8, lines 12-23).

41. With respect to claims 11-13, Hull discloses an encryption module for encrypting the received facsimile data (col. 8, lines 24-47).
42. With respect to claim 14, refer to col. 7, lines 19-23 of Hull.
43. With respect to claims 15-16, refer to col. 8, lines 30-54 of Hull.

Claims 1-50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rozen in view of Melen U.S. Patent No. 6,426,806.

44. With respect to claim 17, Rozen discloses a system (service provider) comprising:

a processor (fax machine at the service provider for receiving the fax from the participant in col. 9, lines 20-25) having means for receiving facsimiles containing various types of information from a plurality of corresponding sources of said information via facsimile devices (col. 6, lines 49-67); and

said processor (the fax machine having a scanning function) being coupled to said facsimile devices via a public-switched telephone network (note that transmitting fax data via PSTN to the recipient is well known to one of ordinary skill in the art at the time of the invention), wherein said processor is configured to receive from said facsimile devices a transmission of a facsimile image of documents containing said various types of information, wherein each set of documents is sent along with identification information thereon (col. 7, lines 4-14), said information used to associate

each set of said documents with an account, wherein said processor is configured to store said facsimile image of said documents in said account associated with said information (col. 7, lines 4-14), and, upon a request received via a telephone at any time, to transmit said facsimile image of said documents from said account associated with said coded information to a user designated facsimile device (col. 8, lines 30-64).

As the applicant pointed out in the Remark filed on 5/2/06, according to Rozen, the participant's faxed documents must be scanned manually at the service provider. Examiner agrees with this statement. However, the Examiner takes an Official Notice that scanning a document by the conventional facsimile machine for producing digital image and storing the digital image is well known in the facsimile art. Thus, when the various types of participant's documents are received by the facsimile machine at the service provider, it would have been obvious to one of ordinary skill in the art to use the same facsimile machine (equivalent for the claimed processor) for scanning the received facsimile documents for producing/storing the digital image in the storage for later retrieval. The motivation/suggestion for doing so would have been to eliminate the burden of having an extra scanning device at the service provider.

Rozen, however, does not explicitly disclose that the facsimile devices transmit the document along with a separate facsimile form having a coded information thereon, said coded information used to associate said document with the account.

Melen, the same field of endeavor of storing the scanned data in a database for later retrieval, discloses a scanner for scanning a cover sheet along with documents, wherein the cover sheet includes a barcode for identifying account associated with the

documents and designates a storage location where the documents should be stored (col. 2, line 17 – col. 3, line 26).

At the time of the invention, it would have been obvious to one of ordinary skill in the art to incorporate the scanning device for reading the barcode and identifying account of Melen into the facsimile machine of Rozen.

The suggestion/motivation for doing so would have been to increase the accuracy in identifying the patient's account by applying the barcode in the facsimile cover sheet and scanning the cover sheet at receiving side.

Therefore, it would have been obvious to combine Rozen with Melen to obtain the invention as specified in claim 17.

45. With respect to claim 18, Rozen discloses the system, wherein said information is a medical record (col. 6, lines 49-67).

46. With respect to claim 19, read col. 2, line 17 – col. 3, line 26 of Melen.

47. With respect to claim 20, a barcode generator must be there to generate the barcode.

48. With respect to claim 21, as noted above in claim 17, Rozen discloses the system for transmitting the medical record to the service provider. Rozen, however, does not explicitly disclose the location where the participant is sending his/her medical records form. It is noted that since the service provider is operable to receive facsimile data transmitted from any facsimile device in the network, it is apparent to one of ordinary skill in the art that the participant sends the medical records from a medical facility where a facsimile machine is located.

Furthermore, referring to the teaching of Melen, upon detecting the barcode information on the cover sheet, the documents automatically stored in the database (col. 2, line 17 – col. 3, line 15).

With respect to claim rest of the claim, arguments analogous to those presented for claim 17, are applicable.

49. With respect to claim 22, read col. 6, lines 49-67 of Rozen.
50. With respect to claim 23, col. 2, line 17 – col. 3, line 15 of Melen.
51. With respect to claim 24, col. 2, line 17 – col. 3, line 15 of Melen.
52. With respect to claim 25, col. 2, line 17 – col. 3, line 15 of Melen. As noted above, a barcode generator is an inherent feature.
53. With respect to claim 26, arguments analogous to those presented for claim 21, are applicable.
54. With respect to claim 27, read col. 7, lines 4-14 of Rozen.
55. With respect to claim 28, read col. 7, lines 4-14 of Rozen.
56. With respect to claim 29, col. 2, line 17 – col. 3, line 15 of Melen.
57. With respect to claim 30, read col. 9, lines 20-47 of Rozen.
58. With respect to claims 31-33, read col. 7, lines 35-39 of Rozen.
59. With respect to claim 34, read col. 8, lines 14-64 of Rozen.
60. With respect to claims 35 and 36, read col. 7, lines 35-39 of Rozen. Further, since the encryption technique is used for the security purposes, it would have been obvious to include the decryption module to decrypt the encrypted data upon detecting that the recipient is an authorized viewer of the document.

61. With respect to claim 37, arguments analogous to those presented for claim 21, are applicable.
62. With respect to claims 38-40, arguments analogous to those presented for claims 22-24, are applicable.
63. With respect to claim 41, arguments analogous to those presented for claim 17, are applicable.
64. With respect to claim 42, read col. 6, line 23 of Rozen (insurance coverage).
65. With respect to claim 43, read col. 6, lines 1-3 of Rozen.
66. With respect to claim 44, read col. 5, lines 49-67 of Rozen.
67. With respect to claim 45, read col. 6, lines 12-32 & col. 8, lines 14-64 of Rozen.
68. With respect to claim 46, read col. 6, lines 12-32 & col. 8, lines 14-64 of Rozen.
69. With respect to claim 47, read col. 5, lines 49-67 of Rozen.
70. With respect to claim 48, read col. 6, lines 1-3 of Rozen.
71. With respect to claim 49, read col. 7, lines 1-3 & lines 40-67 of Rozen.
72. With respect to claim 50, read col. 7, lines 1-3 & lines 40-67 of Rozen.
73. With respect to claim 1, arguments analogous to those presented for claim 17, are applicable. Referring to the teaching of Melen, upon detecting the barcode information on the cover sheet, the documents automatically stored in the database (col. 2, line 17 – col. 3, line 15).
74. With respect to claims 2-16, arguments analogous to those presented for claims 22-36, are applicable.

Claims 51 and 52 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Rozen and Melen as applied to claim 1 above, and further in view of Sheehan et al. U.S. Patent No. 6,311,163 (hereinafter Sheehan).

75. With respect to claims 51 and 52, the combination discloses the system as claimed in claim 1, but it does not disclose explicitly a second coded information corresponding to a second account in said processor, whereby said same facsimile image of said original document is stored in said account associated with said coded information and said second account associated with said second coded information.

Sheehan, the same field of endeavor of the network medical data exchange system, teaches a method for authorizing a second party with a second account to access the same medical information data stored associated with a first account (col. 4, lines 40-57).

Moreover, Melen teaches the method of communicating ID information using a barcode.

At the time of the invention, it would have been obvious to one of ordinary skill in the art to incorporate the Sheehan method for accessing the same medical information by the second party into the system taught by the combination of Rozen and Melen. Further, it would have been obvious to implement the barcode method to identify/associate the user with appropriate medical data.

The suggestion/motivation for doing so would have been to permit the patient's doctor to access the patient's medical record by using the second account associated

with the doctor. Moreover, by authorizing the second account to access the same medical data, it would provide a speedy access of the medical record to the doctor.

Therefore, it would have been obvious to combine three references to obtain the invention as specified in claims 51 and 52.

Contact Information

76. Any inquiry concerning this communication or earlier communications from the examiner should be directed to CHAN S. PARK whose telephone number is (571) 272-7409. The examiner can normally be reached on M-F 8am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Moore can be reached on (571) 272-7437. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Chan S. Park
Examiner
Art Unit 2625

csp
June 9, 2006

DOUGLAS Q. TRAN
PRIMARY EXAMINER



